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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : B. Jack Longley
Serial No. : 09/474,478 Group Art Unit: 1623
Filed : December 29, 1999 Examiner: R. Gitomer
For : METHODS FOR INHIBITING CUTANEOUS INFLAMMATION AND HYPERPIGMENTATION

TECH CENTER 1600/2000

1185 Avenue of the Americas
New York, New York 10036
January 16, 2001

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO JULY 13, 2000 OFFICE ACTION AND PETITION FOR A FIVE MONTH EXTENSION OF TIME

This Communication is submitted in response to a July 13, 2000 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to the July 13, 2000 Office Action was initially due August 13, 2000. Applicants hereby petition for a five month extension of time. Applicants have previously established small entity status. The required fee for a five month extension of time for a small entity is \$945.00 and a check in this amount is enclosed. Therefore, a response is now due January 13, 2001. However, since January 13, 2001 is a Saturday, pursuant to 37 C.F.R. §1.7, a response filed on the next succeeding day which is not a Saturday, Sunday or Federal Holiday, i.e. Tuesday January 16, 2001 is considered timely. Accordingly, this Communication is being timely filed.

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Restriction Requirement Under 35 U.S.C. §121

The Examiner stated that this application contains claims directed to the following patentably distinct species of the claimed invention: methods of treating the following disorders: dermatitis; hyperpigmentation; asthma; cutaneous inflammations;

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anaphylaxis; bronchospasm; mastocytosis; urticaria; hypersensitivity reactions; tumors; and contraception.

The Examiner also stated that this application independently contains claims directed to the following substances or mechanisms to treat the disorders: inhibiting KIT protein; inhibiting chymase; inhibiting elastase; inhibiting SCF cleaving enzymes; inhibiting ligand binding with antibodies, with peptides, or with non-peptides; inhibiting KIT dimerization; inhibiting downstream KIT activation; administering monoclonal antibodies of many different types; and administering organic compounds.

The Examiner stated that applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner stated that currently no claims are generic. The Examiner stated that applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. The Examiner stated that an argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. The Examiner stated that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. The Examiner stated that if claims are added after the election, applicants must indicate which are readable upon the elected species.

The Examiner stated that should applicant traverse on the ground that the species are not patentably distinct, applicant should

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submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. The Examiner stated that in either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. The Examiner stated that applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

In response to this restriction requirement, applicant's undersigned attorney, on behalf of applicant, hereby elects, with traverse, the following species:

- a. method of preventing or treating cutaneous inflammation, as recited in claim 2; and
- b. inhibiting KIT protein, as recited in claim 12.

In addition, applicants request that upon the allowance of a generic claim, consideration of claims to additional species which are written in dependent form be considered.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invites the Examiner to telephone them at the number provided below.

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No fee, other than the enclosed \$945.00 fee for a five month extension of time, is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

John P. White
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I hereby certify that this correspondence
is being deposited this date with the U.S.
Postal Service with sufficient postage as
first class mail in an envelope addressed
to: Assistant Commissioner for Patents,
Washington, D.C. 20231.

John P. White
Reg. No. 28,678
Spencer H. Schneider
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1/16-01

Date